



## UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/500,736 02/09/00 ROGONE

M M-7599 US

024251 PM82/0606  
SKJERVEN MORRILL MACPHERSON LLP  
25 METRO DRIVE  
SUITE 700  
SAN JOSE CA 95110

EXAMINER

SANTOS,R

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 06/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Priority Papers:

- (1) The Commissioner of Patents and Trademarks has determined that the following papers are priority papers:
- (1) The priority date of the present application is the same as the priority date of the following application:
- (1) The priority date of the present application is earlier than the priority date of the following application:

Priority under 35 U.S.C. § 149

(1) An Agent's Report dated 06/06/01, for the property assigned to U.S.C. § 149, was filed in the Office on 06/06/01.

(1) Certified copies of the priority documents were received.

(1) One or more of the priority documents was received in reduced form.

(1) Copies of the priority documents of the patent application have been prepared and sent to the following Office of the Patent and Trademark Office:

Fee for priority documents: \$10.00 for each document.

(1) An Agent's Report dated 06/06/01, for the property assigned to U.S.C. § 149, was filed in the Office on 06/06/01.

## Priority Date:

- (1) The priority date of the present application is the same as the priority date of the following application:
- (1) The priority date of the present application is earlier than the priority date of the following application:

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/500,736	ROGONE ET AL.
	Examiner Robert G. Santos	Art Unit 3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 March 2001.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- |   |  |
|---|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 20) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC §102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,351,348 to Beger. As concerns claims 1, 13, 15, 18, and 21, Beger '348 shows the claimed limitations of a "device" (1) for supporting and maintaining proper positioning and bodily alignment of a neonate, the device comprising a "substantially conformable member" or "pad" (2) defining an area large enough to accommodate a neonate; and a "plurality of support members" (5a-5d) coupled to a portion of the conformable member or pad to define a torso area thereon, each support member being movable from a first position where each of said support members are conformed to a first posture of said neonate to a second position where each of said support members is conformed to a second posture of said neonate, said support members when in said second position providing support to said neonate when said neonate is placed on said conformable member to facilitate the repositioning of the neonate (see Figure 1; column 3, lines 27-41 & 51-61). As concerns claims 2, 16, 17, and 19, the reference also discloses a condition wherein the positioning of the neonate from a first posture to a second posture is accomplished without direct physical contact between a caregiver and the neonate (see column 2, lines 12-21 & 24-32).

With regards to claim 3, the reference is considered to show the use of "fastening means" (3a-3d, 7a-7d) for coupling each of the support members to a portion of the conformable member in Figure 3 and in column 3, lines 30-39 & 61-65. As concerns claim 4, the reference is considered to show a condition wherein the fastening means comprises a "plurality of hollow sleeves" (3a-3d), coupled to a portion of said conformable member (2), wherein each hollow sleeve has an open end to insertably receive one of the plurality of support members (5a-5d) in Figures 1 & 3 and in column 3, lines 30-41. With regards to claim 5, the reference discloses a condition wherein each of the support members (5a-5d) is removably coupled to the conformable member (see column 5, lines 7-13). As concerns claims 6 and 7, the reference discloses a condition wherein the conformable member (2) comprises a "material having a density sufficient for cushioning the neonate" and a "structure taken from the group consisting of a padded blanket and a padded mattress" (see column 2, lines 16-21 and column 3, lines 27-29).

With regards to claims 8 and 9, the reference discloses a condition wherein the plurality of support members comprises a "transverse support member" (5d) coupled substantially transversely along a head end of the conformable member; and a "pair of lateral support members" (5a, 5b) coupled substantially along opposing lateral edges, the pair of support members defining a torso area on the conformable member (see Figures 1 & 3 and column 3, lines 39-41). As concerns claims 10 and 11, the reference also discloses a condition wherein each of the plurality of support members comprises a "sealable collapsible bag" having a filler material taken from the group consisting of "polystyrene beads, down feathers, resilient foam, air, liquid, flaxseed and silicon gel" (see column 3, lines 39-41 & 45-50 and column 4, lines 64-66). With further regards to claim 12 and as concerns claim 14, the reference is considered to

show a condition wherein the neonate is supported on a portion of the conformable member in either "a supine, a prone, and a side-lying position" in column 2, lines 25-33 and in column 4, lines 38-41. As concerns claim 20, the reference discloses the step of "removing a support member" (5<sup>1</sup>c) from the positioner (see Figure 4 and column 4, lines 38-41).

***Response to Amendment***

In response to Applicants' arguments on page 5 of their amendment stating that Beger does not teach or suggest the use of support members "which would aid in the positioning or alignment of a neonate" or which are used "to reposition an infant through manipulation of one of the support members...without the need for human touch between the infant and the care-giver", the examiner respectfully asserts that the Beger reference still properly anticipates the claims since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). More specifically, the Beger reference is considered to still properly anticipate the claims since it discloses the structural limitations of a device comprising a conformable member or pad and a plurality of support members coupled to the conformable member or pad, wherein each support member is movable from a first position to a second position as recited in the claims.

Additionally, in response to Applicants' argument on page 5 of their amendment stating that none of the support members of Beger is "capable of causing the position of the neonate to vary when being moved", the examiner respectfully disagrees, and asserts that each of the

support members is indeed capable of causing the position of the neonate to vary when being moved simply when the neonate is placed in direct contact with any of the support members. With further regards to claim 15, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Accordingly, the claim rejections under the Beger patent have been respectfully maintained.

*Conclusion*

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - 1) U.S. Patent No. 6,097,294 to Hilton
  - 2) U.S. Patent No. 6,054,926 to Deleo
  - 3) U.S. Patent No. 6,049,929 to Rawson
  - 4) U.S. Patent No. 5,937,461 to Dombrowski et al.
  - 5) U.S. Patent No. 5,347,669 to Neviaser et al.
  
4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert G. Santos whose telephone number is (703) 308-7469. The examiner can normally be reached on Mondays through Fridays, 10:30 a.m. to 7:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H. Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-3687 for regular communications and (703) 308-3687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Robert G. Santos  
Examiner  
Art Unit 3628



LYNNE H. BROWNE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3620

R.S.  
June 4, 2001